

**REMARKS**

The Examiner has rejected Claims 41-46 under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 5,961,758 to Honegger ("Honegger") in view U.S. Patent No. 6,656,103 to Neubauer, et al. ("Neubauer").

The Examiner has also rejected Claims 41, 46, and 47 under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 6,363,851 to Gerhard, et al. ("Gerhard") in view of U.S. Patent No. 3,216,719 to Flora ("Flora") and further in view of Neubauer.

The Examiner has also rejected Claim 48 under 35 U.S.C. § 103(a) as being unpatentable over Gerhard, Flora, and Neubauer and further in view of U.S. Patent No. 5,662,448 to Graushar, et al. ("Graushar"). In addition, the Examiner has also rejected Claims 49 and 50 under 35 U.S.C. § 103(a) as being unpatentable over Gerhard, Flora, Neubauer and U.S. Patent No. 3,816,866 to Miaskoff et al. ("Miaskoff").

Claims 26-40 are currently withdrawn. Claims 1-25 stand previously canceled. Claims 26-50 are currently pending. Claim 41 is amended without prejudice hereby. Claims 41-50 stand currently rejected. The following remarks are considered by applicant to overcome each of the Examiner's outstanding rejections to current Claims 41-50. An early Notice of Allowance is therefore requested.

**I. SUMMARY OF RELEVANT LAW**

A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference. The determination of obviousness rests on whether the claimed invention as a whole would have been obvious to a person of ordinary skill in the art at the time the invention was made. In determining obviousness, four factors should be weighed: (1) the scope and content of the prior art, (2) the differences between the art and the claims at issue, (3) the level of ordinary skill in the art, and

(4) whatever objective evidence may be present. Obviousness may not be established using hindsight or in view of the teachings or suggestions of the inventor. The Examiner carries the burden under 35 U.S.C. § 103 to establish a prima facie case of obviousness and must show that the references relied on teach or suggest all of the limitations of the claims.

*KSR* cautions that hindsight reasoning based on the Applicants' own disclosure distorts analysis: "[a] factfinder should be aware, of course, of the **distortion caused by hindsight bias** and must be cautious of arguments reliant on ex post reasoning." Emphasis added. An examiner should not rely on conclusory statements that a particular feature of the invention would have been obvious or was well known. See *KSR*, 550 U.S. at 418, citing *In re Kahn*, 441 F.3d 977, 988 (Fed. Cir. 2006) ("[R]jections on obviousness grounds cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness."). Moreover, the Examiner cannot herself summarily modify a reference without a reason based on a belief that the recitation is well known. As explained in the USPTO guidelines for examination: "When setting forth a rejection, Office personnel are to continue to make appropriate findings of fact as explained in MPEP §§ 2141 and 2143, and must provide a reasoned explanation as to why the invention as claimed would have been obvious to a person of ordinary skill in the art at the time of the invention. This requirement for explanation remains even in situations in which Office personnel may properly rely on intangible realities such as common sense and ordinary ingenuity." <sup>2</sup>

---

<sup>2</sup> Examination Guidelines Update: Developments in the Obviousness Inquiry After *KSR v. Teleflex*, Federal Register / Vol. 75, No. 169 / Wednesday, September 1, 2010

## II. INTRODUCTORY COMMENTS

The Examiner in the response to arguments alleges the Applicants have “attacked the references individually.” This is in error. The Applicants have rather shown that (1) the reasons the Examiner has given for the modification are faulty, (2) the logical combination of the cited references would result in a device that lacks the claimed features, and (3) the references, even when combined, fail to disclose or render predictable the claimed features. Thus the Office Action fails to make a *prima facie* case of obviousness.

In particular, as described in more detail below, the Office Action gives no reason for modifying its primary references with Newbauer’s knife 416 except “to produce a high quality fold,” or because a device is “known.” Moreover, the Office Action assumes that the combined device “as modified” would have the claimed features, but never gives any reasons or cites any facts as to why an ordinarily skilled artisan would combine the features thus. This is inadequate for a *prima facie* case (see Summary of Relevant Law, above), and takes impermissible Official Notice, which applicants traverse (see below).

## III. REJECTION OF CLAIMS 41-46 UNDER 35 U.S.C. § 103(A) OVER HONEGGER AND NEUBAUER

On page 3 of the current Office Action, the Examiner rejects Claims 41-46 under 35 U.S.C. § 103(a) as unpatentable over Honegger and Neubauer. These rejections are respectfully traversed and believed overcome in view of the following discussion.

Claim 41 states, in part:

“a joining device for joining a cover **sheet** to at least one contents **sheet**;

“two guide planes, including a first guide plane and a second guide plane, lying one above the other at a distance from one another and in a parallel orientation to each other, the two guide planes being provided in the vicinity of the folding device, **so that the folding device passes through the guide planes**, for separate placement of the contents **sheet** and cover **sheet** in the first guide plane and the second guide plane, respectively; and

“said folding device being **simultaneously** a joining device so that the sheets can be joined during folding.” (emphasis added).

Applicant respectfully asserts that Honegger in view of Neubauer fails to disclose the above-identified features of Claim 41.

First, the Office Action concedes that Honegger fails to disclose or render predictable a folding device passing through the two guide planes, alleging this is “unclear.” Instead, the Office Action relies on Neubauer to teach such feature.

Honegger does not show a folding device. It is only known that after cutting, Honegger’s apparatus 17 receives a stack 5 which is then folded along the injection line J to a booklet B (col. 3, lines 40-44) . With all due respect, it is not unclear where the folding occurs. It is clear that the folding device of Honegger is used to stack, where contents sheets and cover sheet are **already permanently bound / joined via the liquid binder of injection apparatus 15**. See col. 3, lines 25-30). Thus in the case of Honegger **guide planes are not needed in the vicinity of the folding device**. Joining is already done (press rollers 30) when folding starts.

Claim 41 requires “a joining device for joining a cover sheet to at least one contents sheet...[and] separate placement of the contents sheet and cover sheet in the first guide plane and the second guide plane, respectively, said folding device being **simultaneously** a joining device so that the sheets can be joined during folding.” Thus the claimed device works with multiple sheets, which are already cut. The Office Action misjudges or overlooks that Honegger’s alleged guide planes a fed by an **endless web**. That is why a person who is skilled in the art would never fold the endless web of Honegger in the manner the present claims recite. It is not possible to get a brochure out of an endless web when somebody would first fold, and after folding perform a cut. Such a device would be impracticable and would waste material.

On the other hand, folding a **previously- glued stack** after cutting renders the claimed device superfluous, the claimed folding device being fed sheets and “**simultaneously** a joining device so that the sheets can be joined during folding.” That is to say, the sheets are joined and folded at the same time. In short, there is no reason to modify Honegger to obtain “a joining device for

joining a cover sheet to at least one contents sheet...[and] separate placement of the contents sheet and cover sheet in the first guide plane and the second guide plane, respectively, said folding device being **simultaneously** a joining device so that the sheets can be joined during folding.”

The Office Action is correct, that Neubauer shows a folding device 416. The folding device 416 can fold a folding article 370 consisting of a thick leading portion 380 and a thin trailing portion 382. Before folding, glue can be brought up on the surface of the folded article 370 particularly up on the thick leading portion 380 of the article 370 (col. 13, lines 63 – 66 spots of glue). Then the folding member 416 may be moved downwardly so that it makes contact with the intermediate portion of the folded article 370 (col. 13, lines 47 ff). Over this glue free intermediate portion - the folded article is pushed towards the nip between the folding rollers 418, 420 (col. 14, lines 1-3). It makes sense that knife 416 does not have contact with the glue; otherwise it would not be retractable.

The Office Action thus misjudges or overlooks that Neubauer feeds an **already folded article 370 to folding member 416 and not different single sheets**. There is no differentiation in contents sheet and cover sheet. There is a thick leading portion 380 and a thin trailing portion 382 but they have nothing to do with contents sheet and cover sheet. The glue is brought up on scopes of the thick leading portion of the folded article 370 where the folding device does not effect. The folding device is only for folding in an intermediate portion, where no glue is. The pressure to support the gluing / binding will be ‘affected’ by the folding rollers 418 and 420. As there are no previously folded sheets in Hoggener’s alleged guide area, but instead an endless web, there is no reason to add Neubauer’s folding device to Hoggeer such that “the folding device passes through the guide planes, for separate placement of the contents **sheet** and cover **sheet** in the first guide plane and the second guide plane, respectively.”

Next, the Office Action makes a number of statements that are conclusory and impermissibly take Official Notice,<sup>1</sup> and in error. Applicants traverse. **Thus, in accordance with MPEP 2144.03(D) and** so that the record of prosecution be complete, Applicants respectfully request documentary evidence under 37 C.F.R. 104(e)(2) of the elements recited in the claims or an affidavit of the Examiner under 37 C.F.R. 104(d)(2) setting forth specific factual statements and explanation to support the facts asserted to combine the cited references. These are taken in turn:

**POINT 1:**

At page 3, the Office Action states: "...it would have been obvious to one of ordinary skill in the art to modify the apparatus of Honegger by adding a folding device capable of passing through the guide planes in order to fold **sheets** as taught by Neubauer..." This is in error. As explained above, Neubauer does not show **sheets** folded by folding member 416, but instead shows an **already folded article** 370 in only one guide plane and NOT consisting of more than one sheet.

**POINT 2:**

At pages 3-4, the Office Action goes on to say that the folding member 416 of Neubauer is a "known folding means and enables the apparatus of Honegger to produce a high quality fold." This is also in error. As noted above, Honegger teaches an endless web, not a folded article. The Office Action misjudges or overlooks that Honegger's alleged guide planes are fed by an **endless web**. That is why a person who is skilled in the art would not fold the endless web of Honegger with Neubauer's folding member. It is not possible to get a Neubauer's brochure out of an endless web when somebody would first fold, and after folding perform a cut, as Honegger does. Such a device would be impracticable and

---

<sup>1</sup> See MPEP 2144.03(E): "Any rejection based on assertions that a fact is well-known or is common knowledge in the art without documentary evidence to support the examiner's conclusion should be judiciously applied. Applicants respectfully assert that Official Notice is an insufficient basis to suggest the combination without using Applicants' specification as a blueprint. These features are neither "basic knowledge" nor "common sense." *In re Lee*, 277 F.3d 1338, 1345 (Fed. Cir. 2002) ("Deficiencies of the cited references cannot be remedied by the Board's general conclusions about what is 'basic knowledge' or 'common sense.'").

would waste material. It is simply not correct when the Examiner would imagine to add the folding member 416 to the apparatus from Honegger.

To explain, folding in the Honegger apparatus before cutting, as the Office Action proposes, leads to chaos because of the permanent feed endless web. On the other hand, folding after joining the endless webs and the cutting the thus- joined stack, as Honegger, requires no guide planes for separate placement of the contents sheet and the cover sheet. To the contrary, after cutting, Honegger's are not single sheets -- they are joined already. Folding is only necessary after cutting, not joining.

Finally Honegger takes **press rollers 30** / ultrasonic apparatus 16 (see col. 3, lines 37-39) **to join the endless webs**. Honegger fails to teach to joining with the folding member. Thus taking over knife 416 of Neubauer to the already joined stack of Honegger limits the function of the knife to folding. Joining by knife is not encouraged, as there is no cooperation with the stripe of glue.

Thus it is altogether not the case that an ordinarily skilled artisan would conclude that Neubauer is a "known folding means and enables the apparatus of Honegger to produce a high quality fold," as alleged by the Office Action.

### **POINT 3:**

Page 4 of the Office Action states: "[w]hen the folding device 416 of Neubauer is added to the apparatus of Honegger, said device must be capable of passing through the guide planes in order to fold the sheets of Honegger." This is in error.

Again, the Office Action gives no reasoning whatsoever for the statement. It is wholly conclusory. For example, the Office Action cites no facts as to where on Honegger's apparatus Neubauer's folding member would be added so that it passes through the guide planes. At the location the Office Action suggests adding the folding member 416 of Neubauer, the location where a fold is made, Honegger discloses an already cut and joined stack, and at this location does not have different guide planes. **As the stack is already joined, the folding member 416 would work only for folding, but not for joining the sheets.**

Logically, the teachings of Neubauer lead to placing Neubauer's knife/folding member 416 away from where the glue is:

As the folded article 370 passes through the folding rollers 418 , 420, the article 370 may be folded so that the portion 382 is folded over the portion 380 , with the glue spots disposed between the two portions 380 , 382 so that the resulting outsert remains in a substantially closed orientation with the portions 380 , 382 adhered together.

*Neubauer* col. 14, lines 5-6. Neubauer's press rollers 418, 420 carry out the joining function for the already folded article. Joining and folding are separate functions.

In short, combining Honegger and Neubauer at best results in folding a prepared joined stack, whereby different guide planes are neither necessary and nor possible. Moreover, it makes no logical sense to modify Honegger apparatus to join a stack with the knife of Neubauer. Honegger's joining is performed before cutting by press rollers 30. To add the Neubauer's knife 416 before cutting makes no sense as already described with respect to the Honegger's endless web.

#### POINT 4:

At page 4 of the Office Action states: "The said folding device (416 of Neubauer) is capable of functioning as a joining device." With all due respect, this too is a wholly conclusory assumption.

Next, Neubauer's knife 416 transforms and folds only, so that the areas of the already-folded article 370, which should be joined, are joined after folding. The fact that Neubauer's knife 416 is able act as a joining member is not disclosed anywhere in from Neubauer or Honegger. Thus this is a hindsight conclusion without any support.

#### POINT 5:

Over and above the reasons given, the Office Action's citations and alleged modification fails to address open questions necessary to make a *prima facie* case, for example:

- \* Honegger shows not cut sheets but only a plurality of endless webs one above each other with the separate steps of: 1. gluing, 2. joining, 3. cutting, and 4. folding.

- None of the references as cited show a folding member moving through two guide planes as required by the claims. Honegger folds an already joined stack what is a whole unit.
- The examiner cites no facts or reasoning as to why or how person skilled in the art to fold and joining separate sheets when Neubauer only teaches folding an already folded article 370, which is no longer in sheet form.

For all the reasons above, nether Neubauer or Honegger teach or render predictable “a joining device for joining a cover sheet to at least one contents sheet,” “the two guide planes being provided in the vicinity of the folding device, so that the folding device passes through the guide planes, for separate placement of the contents sheet and cover sheet in the first guide plane and the second guide plane, respectively; and said folding device being simultaneously a joining device so that the sheets can be joined during folding,” as required by the claims. Accordingly, Applicant respectfully asserts that Examiner has failed to establish a prima facie case of obviousness of independent Claim 41, and corresponding Claims 42-46 because they are dependant from independent Claim 41. Therefore, Applicant respectfully requests that Examiner withdraw the rejection of Claims 41-43 and 45 under 35 U.S.C. § 103(a) over Honegger in view of Neubauer.

**IV. REJECTION OF CLAIMS 41, 46, AND 47 UNDER 35 U.S.C. § 102(B) BASED ON GERHARD, FLORA, AND NEUBAUER**

On page 4 of the current Office Action, the Examiner rejects Claims 41, 46, and 47 under 35 U.S.C. § 103(a) over Gerhard, Flora, and Neubauer. These rejections are respectfully traversed and believed overcome in view of the following discussion.

Claim 41 states, in part:

“a joining device for joining a cover **sheet** to at least one contents **sheet**;

“two guide planes, including a first guide plane and a second guide plane, lying one above the other at a distance from one another and in a parallel orientation to each other, the two guide planes being

provided in the vicinity of the folding device, **so that the folding device passes through the guide planes**, for separate placement of the contents **sheet** and cover **sheet** in the first guide plane and the second guide plane, respectively; and

“said folding device being **simultaneously** a joining device so that the sheets can be joined during folding.” (emphasis added).

**Gerhard:**

Gerhard describes an adhesive junction of sheets - the reference has nothing to do with the claimed device. The Office Action recognizes that Gerhard does not have two guide planes, one above another, but assumes there must be joining and folding at the same time. **This is in error.** Gerhard describes folding first, then connecting -- independent of gluing or stapling. Claim 1 and col. 3, lines 1-12 of Gerhard, as cited by the Office Action, give no further information. Gerhard's U-shape with two spaced apart weak lines 4a, 4b provide sufficient space for means for joining. See col. 3, lines 51-54. That means that glue would be filled in after folding.

**Flora:**

Flora discloses a sheet collator / collating machine. Flora discloses a means of bringing groups of sheets into alignment. The stop members of this means are **pivotal** through an aperture in the table. The connection between the sheets is realized by stitching, not by gluing. **The two platforms 64 are not arranged one above the other, but alongside each other, even when they can have different levels in height.**

Flora's platforms 64 are feed mechanism with the function to deliver sheets to a central table 30, □ See Flora at col. 3, 30-32. **There is no folding device in the vicinity of the platforms 64.** Folding and joining in one step and with one device are not described. Folding does not play a role, because of the collating function and purpose.

The Office Action relies heavily on unsupported conclusory statements, and hence Official Notice, to modify the Gerhard's device, thus failing to make a *prima facie* case of obviousness. Applicants traverse,<sup>2</sup>

For example, the Office Action fails to over any facts or reasons as to why an ordinarily skilled artisan would modify Gerhard's

- U-shape with two spaced apart weak lines 4a, 4b
- the separate folding device, and
- the separate joining device

to install platform 64 of Flora and to again install the knife 416 of Neubauer.

The Office Action's alleged citations and modification fails to address open questions necessary to make a *prima facie* case, for example:

- None of the references as cited show a folding member moving through two guide planes as required by the claims.
- The Platforms 64 of Flora can contribute to the delivering of sheets out of a magazine on a central table (Flora – col.3, lines 30-32) – but the platforms themselves are not one above another. The platforms 64 are feeding devices and do not contribute to the folding process. The Office Action gives no reason why or how an ordinarily skilled artisan would modify the platforms 64 such that result in guide planes for different sheets one above another.
- Aligning, binding, and folding are separate steps in Gerhard. See claim 1, see col. 3, lines 11, 12, see D, E, F in Fig. 1. In Gerhard, only the collected stack with a plurality of sheets superimposed upon each other (Gerhard) could be folded, not separate sheets in different guide planes as the recited in the claims. The Office Action gives no reason why or how an ordinarily skilled artisan would modify Gerhard's devices for a plurality

---

<sup>2</sup> See footnote 1.

of sheets superimposed upon each other and being in contact to result in two guide planes with a coversheet not in contact to the contents sheet until the step of folding and joining.

- The Office Action cites no facts or reasoning as to why or how person skilled in the art would look to platforms in Flora's collator as guide planes to modify Gerhard, as it teaches sheet delivery and has nothing to do with joining and folding?

#### V. DEPENDENT CLAIMS

The other claims are dependent from one of the independent claims, discussed above, and are therefore believed patentable for at least the same reasons. As nothing in the prior art cited in the Office Action cures the above-identified deficiencies, Applicant respectfully requests reconsideration and withdrawal of the rejections. As each dependent claim is also deemed to define an additional aspect of the invention, however, the individual reconsideration of the patentability of each on its own merits is respectfully requested.

Similarly, because Applicant maintains that all claims are allowable for at least the reasons presented hereinabove, in the interests of brevity, this response does not comment on each and every comment made by the Examiner in the Office Action. This should not be taken as acquiescence of the substance of those comments, and Applicant reserves the right to address such comments.

#### CONCLUSION

In the event the Examiner disagrees with any of statements appearing above with respect to the disclosure in the cited reference or references, it is respectfully requested that the

Examiner specifically indicate those portions of the reference or references, providing the basis for a contrary view.

Based upon the above remarks, Applicant respectfully requests reconsideration of this application and its early allowance. Should the Examiner feel that a telephone conference with Applicant's attorney would expedite the prosecution of this application, the Examiner is urged to contact him at the number indicated below.

Please charge any additional fees that may be needed, and credit any overpayment, to our Deposit Account No. 50-0320.

Respectfully submitted,

FROMMER LAWRENCE & HAUG LLP  
Attorneys for Applicant



---

Eugene LeDonne -- Reg. No. 35,930  
Brian M. McGuire -- Reg. No. 55,445

EL:BMM

135431.2001